

REMARKS

This amendment is submitted with a Request for Continued Examination and a request for a three month extension of time in reply to the outstanding final Office Action dated January 3, 2006. Claims 1-11 currently stand rejected. Applicants respectfully traverse these rejections and have added new claims 12-17 to further define patentable aspects of the invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §103

Claims 1-3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crill et al. (U.S. Patent No. 6,445,822, hereinafter, Crill) in view of Gutberlet, L., "Peer-to-Peer Computing – A Technology Fad or Fact?", 10/10/2000 (hereinafter, "Gutberlet"). Claims 4-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crill in view of Gutberlet, further in view of Schneier, B., "Applied Cryptography", 1996 (hereinafter, "Schneier"). Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Crill in view of Cooperman et al. (U.S. Patent No. 5,613,004, hereinafter "Cooperman"). Claims 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crill in view of Cooperman further in view of Gutberlet. Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Crill in view of Gutberlet further in view of Duplic8 ("Duplicate file manager", 10/9/1999, pp. 1-5). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Crill in view of Cooperman further in view of Duplic8. Applicant respectfully traverses.

I. The independent claims are patentable

As previously argued, independent claims 1 and 7 recite, *inter alia*, collecting an illegally produced digital music file according to a kind of music of the digital music file. In other words, for example, digital music files are collected according to their kind of music. The Office Action asserts that Crill discloses the above feature at col. 16, line 65 to col. 21, line 47. The cited

passage of Crill discloses a method of comparing candidate and reference images in which lower resolution versions of both the candidate and reference images are produced prior to comparison in order to increase the speed and efficiency of the comparison. In this regard strings of numbers correlating to the lower resolution versions of the candidate and reference images are compared and a difference is computed. As such, the Office Action asserts that if the difference computed is small, then a closer match exists between the two images. However, the Office Action then asserts that “since a particular kind of music would have images closer to each other, the smaller difference would show a correspondence in kind of music.” Applicants respectfully disagree with this assertion.

Applicants respectfully point out that the assertion above appears to find its basis in the Examiner’s own personal knowledge since there is no basis for the statement to be found in Crill or any other cited reference. The Examiner can use “common knowledge” in a rejection by taking official notice of a fact, however, according to MPEP 2144.03, it is not appropriate to do so unless the facts asserted are capable of instant and unquestionable demonstration as being well-known. Applicants respectfully submit that it is far from capable of instant and unquestionable demonstration as being well known that lower resolution versions of similar kinds of music have small differences. Such an assertion would imply that, if heard or perhaps viewed at a lower resolution, all country music sounds or looks the same, or that all rock music is nearly identical when heard at a lower resolution. To the contrary, Applicants respectfully submit that such an assertion would more commonly be viewed as incorrect or at least arguable and therefore is not common knowledge. Additionally, as was stated in MPEP 2144.03 regarding *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d at 1697, “the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” Accordingly, even if in the Examiner’s experience, the assertion above is correct, Applicants respectfully request that the Examiner point to some concrete evidence in the record to support such a finding. Since no basis can be found for the Examiner’s statement that “since a particular kind of music would have images closer to each other, the smaller difference would show a correspondence in kind of music”,

Applicants “seasonably challenge” the Examiner’s use of personal knowledge to fill in the gap under MPEP 2144.03 citing the patent laws.

Accordingly, Applicants respectfully submit that Crill fails to teach or suggest collecting an illegally produced digital music file according to a kind of music of the digital music file as claimed in independent claims 1 and 7.

Gutberlet discloses digital rights management (DRM) in which content files may be encrypted in order to require a “license” prior to execution of the content files. Gutberlet fails to teach or suggest collecting an illegally produced digital music file according to a kind of music of the digital music file as recited in independent claims 1 and 7. Neither is Gutberlet cited as teaching such feature.

Schneier is directed to methods of public key encryption, Cooperman is directed to methods of watermark encryption and Duplic8 is directed to a device for eliminating duplicate files. Schneier, Cooperman and Duplic8 each fail to teach or suggest collecting an illegally produced digital music file according to a kind of music of the digital music file as recited in independent claims 1 and 7. Furthermore, Schneier, Cooperman and Duplic8 are not cited as disclosing such feature.

Since Crill, Gutberlet, Schneier, Cooperman and Duplic8 each fail to teach or suggest the aforementioned features of independent claims 1 and 7, any combination of the cited references also fails to teach or suggest the subject matter of independent claims 1 and 7. Thus, the cited references, taken either individually or in combination, do not anticipate, or render independent claims 1 and 7 obvious.

II. The dependent claims are patentable

Claims 2-6 and 8-11 depend either directly or indirectly from a respective one of independent claims 1 and 7, and as such, include all the recitations of their respective independent claims. The dependent claims 2-6 and 8-11 are therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claims 1 and 7.

Furthermore, although the dependent claims are patentable at least by virtue of their

dependency from patentable independent claims, Applicants respectfully submit that there are yet further reasons for the patentability of at least some of the dependent claims. In this regard, claims 10 and 11 recite, *inter alia*, that collecting the illegally produced digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time. The Office Action rejects the claims above in view of a combination of either Crill, Gutberlet and Duplic8 (claim 10) or a combination of Crill, Cooperman and Duplic8 (claim 11). In this regard, the Office Action admits that the above recited feature is neither taught nor suggested in any of Crill, Gutberlet or Cooperman. Accordingly, the Office Action asserts that the above recited feature is disclosed in Duplic8. Applicants respectfully disagree with this analysis and in any case, submit that Duplic8 is an improper reference.

Duplic8 is directed to a software application that finds and deletes duplicate files. As such, Duplic8 is an improper reference since it relates to a non-analogous art. To rely on a reference under 35 U.S.C. §103, it must be analogous prior art. See MPEP 2141.01(a). The two-part test for analogous art requires that “the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *State Contracting & Eng’g Corp. v. Condotta America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed.Cir. 2003) (where if the general scope of a reference is outside the pertinent field of endeavor, the reference may still be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). As stated above, Duplic8 is directed to deleting duplicate files. The problem to be addressed in this art is determining which files are identical from among a group of files that may have different names in order to delete duplicate files and save memory space. To the contrary, the claimed invention is directed to preventing illegal distribution of digital music files. The problem to be addressed in the art of the claimed invention is developing a way to identify illegal files and modify (not delete) the files for redistribution in an undesirable format. Thus, Duplic8 and the present application are concerned with very different problems. Additionally, Duplic8, on the one hand, and the present application, on the other hand, are simply and plainly not in the same field of endeavor with Duplic8 being used in a resource consumption

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management field while the present application is utilized in a loss prevention field. Therefore, Duplic8 is not reasonably pertinent to the particular problem with which the inventor was concerned nor in the same field of endeavor. Thus, Duplic8 is not analogous art and, therefore, cannot be relied upon to support an obviousness rejection under 35 U.S.C. §103.

However, even if one were to assume for the sake of argument that Duplic8 is analogous art (an assumption with which Applicants expressly disagree), Duplic8 still fails to teach or suggest the claimed feature. In this regard, the FAQ section of Duplic8 discloses that many files may be saved that are identical except that they have different names (see section regarding "what is so special about Duplic8"). Accordingly, Duplic8 is designed to perform a byte by byte comparison of the file, excluding the name, in order to detect identical files having different names. Since Duplic8 at least ignores the name of the file in order to detect otherwise identical files, Duplic8 fails to teach or suggest that collecting the illegally produced digital music file comprises selecting one of a plurality of digital music files having a same name, size and playing time as claimed in dependent claims 10 and 11.

Accordingly, for all the reasons above, Applicants respectfully submit that the rejections of claims 1-11 are overcome.

Newly Added Claims

Applicant has added new claims 12-17 to more particularly define aspects of the present invention. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

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CONCLUSION

In view of the amended claims, the new claims and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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